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1714 ✓
ROHM AND HAAS

Fax

To: Inger H. Eckert

From: Robert W. Stevenson

Fax: (740) 321-8024

Pages: 25 (including coversheet)

Phone:

Date: November 25, 2003

Re: Chen U.S. Patent Application

CC:

☐ **Urgent** ☐ **For Review** ☐ **Please Comment** ☐ **Please Reply** ☐ **Please Recycle**

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Application and transmittal letters to follow by U.S. Mail.

Bob Stevenson

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Bob Stevenson



November 26, 2003

Inger H. Eckert
Director, Intellectual Property
Owens Corning
Science & Technology Center
2790 Columbus Rd., Route 16
Granville, OH 43023

Via Facsimile and U.S. Mail
(740) 321-8024

Re: **Chen U.S. Patent Application No. 09/871,467**
(U.S. Patent Publication No. 2002/018805)

Dear Ms. Eckert:

Thank you for your letter of November 14, 2003. As a threshold matter, we do not think there is anything improper about our filing our continuation case, given that Mr. Dobrowolski, an employee of Rohm and Haas, was at the very least a co-inventor of subject matters set forth in the captioned patent application, according to our best understanding of the facts. Filing our continuation is the only way for us to preserve any rights that we might have, as you probably realize. Giving Owens Corning the benefit of the doubt, we believe it is operating under a misunderstanding of the inventorship facts, some of which might not be known to you personally, for example.

We have offered an alternative to an interference in the form of some sort of arbitration, in order to clear up the parties' understandings of what the inventorship facts really are. I had carefully considered your letters of April 2, 2002 and June 13, 2003 when I sent my October 31st letter, but frankly, each of the proposals contained in your letters didn't limit themselves to resolving the simple factual issue of co-inventorship in an arbitration. Instead, each proposed a penalty on Rohm and Haas that no adverse or favorable interference decision ever could impose (e.g., waiver of all prior art defenses, exclusivities, royalties). Certainly, it would be unreasonable for us to agree to royalties and/or exclusivities without a full exploration of the facts, that might only under appropriate factual circumstances allow for such contractual arrangements. Your proposals, among other things, put the contractual cart before the factual investigation horse. And your November 14th letter simply reiterated your prior proposals. So your proposals were not reasonable in view of the interference alternative where we would at least gain a good factual understanding of where the parties stood, and make that alternative more, not less, attractive. Be that as it may.

We presently have another proposal for you to consider: namely, abandoning your case in light of the prior art (U.S. Patent No. 6,071,994 to Hummerich et al.; Exhibit A) we recently found. A summary of that Section 102 art applied to the pending claims in your application is attached (Exhibit B). After you review this, we would be very interested in ascertaining from you what

patentable subject matter, if any, you believe remains in your application in light of this art. If you think there is anything patentable left, we would propose a narrowly focused interference on that subject matter, if appropriate. If there is nothing left, we would both agree to abandon our respective applications.

Should you believe there is any narrow patentable subject matter left, we can discuss it, and if you would agree not to pursue broader protection, we could abandon our application if the facts as we understand them don't support co-inventorship of such narrow subject matter. You, in turn, would make voluntary narrowing amendments to your claims.

We believe this is a reasonable proposal under these circumstances.

As soon as we get a serial number and a confirmed Examiner assignment in our case, we will be citing Hummerich to the Examiner, and providing a copy of this letter and our attached analysis (Exhibit B). We suggest you provide both to the Examiner in your case much sooner, consistent with the duty of candor, if you choose to continue prosecution of your case. Citing our letter and analysis would ensure that the Examiner would not inadvertently overlook the relevance of this new art brought to her attention late in prosecution and possibly in the haste of allowing your case at year's end. It is a fairly long patent to read, after all. Our analysis would facilitate her review and consideration of this art. At least out of courtesy if not candor, you should provide it to her.

We also think that our Section 102(f) issue is a matter Owens Corning should inform the Examiner about, given that it is material information that an Examiner should know in examining your application for patentability.

Also, Owens Corning should be considerably more forthcoming to the Examiner about what we understand to be a long historical use of mineral oil as a dust suppressant in connection with fiberglass insulation production, including insulation made with binders. Our understanding is that Owens Corning and other insulation manufacturers have for years used dust suppression oils as a common practice in this industry, to reduce or eliminate the obvious and long-understood health hazards associated with airborne fiberglass particles. For example, the International Programme on Chemical Safety, Environmental Health Criteria, World Health Organization 1988 stated: "**MMMF [Man-made mineral fibers] usually contain a binder and mineral oil as a dust suppressant.**" (see Exhibit C, p. 6).¹ Also Hummerich characterizes mineral oil as a "customary" additive substance in fiberglass to suppress dust (see col. 10, lines 46-53). Indeed, when Mr Dobrowolski gave Owens Corning his surfactant-containing binder, that was his understanding. How could it not have been? Because of the paucity of art cited by Owens Corning, the file history in your case does not reflect that the Examiner has become aware of this apparent long standing customary industry practice. We plan to explain this to her in the near future in our case, and suggest you do likewise – and fully with all the art in Owens Corning's possession (including but not limited to the full extent of Corning's own Section 102(b) commercial practices) to show precisely and with clarity how common and long term this

¹ A full copy is available at <http://www.inchem.org/documents/ehc/ehc/ehc77.htm>.

commercial practice has been. Indeed, because we don't manufacture fiberglass, Owens Corning is in a much better position than we are to explain to the Examiner how common and extensive this practice has been.

This apparent long customary industry practice has bearing, among other things, on the relevance of Reck U.S. Patents Nos. 6,099,773 and 6,348,530 as potential Section 102 (as opposed to Section 103) prior art. If the use of dust suppressant agents is as common as we believe (see, e.g., Exhibit C, U.S. Patent No. 5,108,798 and Owens Corning's own patent filings including U.S. Patents Nos. 4,542,044, 4,909,817 and 5,624,742), we posit that the reader of Reck would read his patent as teaching the practice of what is disclosed by him in the intended environment, namely, with necessary and usual additives such as dust suppressants that most -- if not every -- responsible fiberglass manufacturer has to use.² We are rather surprised that Owens Corning, given its obvious knowledge of the ubiquitous use of dust suppressant oils in prior art commercial practices, has not been forthcoming about this to the Examiner as of yet, unless, of course, we are somehow factually mistaken about these practices.

Indeed, if our understandings are correct and Owens Corning were more forthcoming about dust suppressant agents, we believe that even Owens Corning would agree that it would not be able persuasively to state a case of patentability of its currently pending claims over Reck. Your prosecution history has left an impression -- rightly or wrongly -- that Owens Corning by its silence to the Examiner about this matter is prepared to permit her to allow claims over Reck due simply to the addition of a dust-suppressant agent that Owens Corning knows to be long-standing industry standard practice that Reck and readers of Reck obviously knew and would employ with Reck's ideas as a matter of course practicing what Reck otherwise expressly taught. If our understandings about dust suppression are correct, Reck apparently felt it unnecessary to mention the usual, customary practices. It's human nature sometimes -- and maybe more so with scientists and engineers -- not to state the obvious and self-evident.

In response to this letter, we would like you to correct and to explain in detail why our understandings about dust suppression agents might be inaccurate, or advise us if we are correct. Such an explanation or advice, for example, might be helpful to our decision about what we should do about the continuation application that we filed. If our understandings are correct, your own careful consideration of this issue may provide Owens Corning an additional reason to respond favorably to our current proposal.

One final matter: you should advise the Examiner of the existence of our commonly owned co-pending application. Copies of the filing papers are enclosed with the confirmation copy of this letter. Because we copied the pending claims in your application (with a few corrections in claim dependency that you probably want to make as well), this raises an issue of patentability

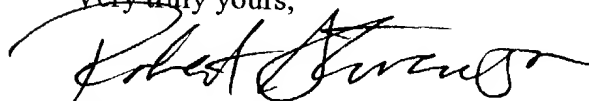
² We have found, for example, that oil companies have long marketed oils for the use in the manufacture of fiberglass insulation (see, e.g. the 76 Lubricants Company "Steaval D" brochure attached as Exhibit D). Owens Corning -- and its inventors -- probably have a fair amount of similar prior art commercial literature in their files like this one. A full citation of such commercial literature is in order in your prosecution. We suggest you search Owens Corning's files for such relevant information.

Inger H. Eckert
Director, Intellectual Property
November 26, 2003
Page 4

under Section 101 of which the Examiner should be made aware in connection with your prosecution.

We look forward to hearing from you in the very near future with your reply to our current proposal and to the other points in this letter. We remain, as we have been, willing to cooperate with you in reaching a reasonable resolution of this matter. We think our current proposal represents a way for us to move forward, and to put these unfortunate misunderstandings behind us.

Very truly yours,

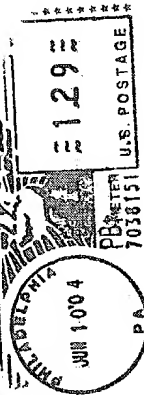
A handwritten signature in black ink, appearing to read "Robert W. Stevenson", written over a horizontal line.

Robert W. Stevenson
Senior Patent Counsel

RWS/jal
Enclosures

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